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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,123	06/30/2003	Kennon Yi	T3465-908318	3029
181	7590	04/06/2005	EXAMINER	
MILES & STOCKBRIDGE PC 1751 PINNACLE DRIVE SUITE 500 MCLEAN, VA 22102-3833			DANG, HUNG XUAN	
			ART UNIT	PAPER NUMBER
			2873	

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/608,123	YI, KENNON	
	<b>Examiner</b>	<b>Art Unit</b>	
	Hung X. Dang	2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 13-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. Applicant's election of Group I, claims 1-12 is acknowledged. The traversal is on the ground(s) that "The Examiner bases his requirement for restriction/election on the assertion that currently no claim is generic and the application is directed to patentably distinct species. Applicants respectfully disagree. The Examiner's attention is invited to Claim 1 which is generic to all species. Claim 1 calls for eyewear comprising a first and a second lens, a half-jacket frame adapted to receive both lenses and a removable shield for reducing direct impingement of moving unfiltered air and dust. With reference to Claim 13, the fact that Claim 13 identifies an additional element such as a the nose contacting element attached on the half jacket frame front does not exclude Claim 1 which is generic thereto. Claim 13 could just as easily have been written as --Eyewear as set forth in Claim 1 wherein the half jacket frame front has a nose contacting element--. Likewise, Claim 20 could have been written directly dependent from Claim 1 but claiming the lens retaining grooves in that frame front Claim 26 likewise falls into this category.

The only possible bases for a proper election requirement are those claims directed to the method of protecting the eyes of a motorcycle rider in Claims 27-28. In view of the foregoing, reconsideration and withdrawal of the restriction requirement is requested with respect to all claims, with the exception of Claims 27 and 28, as Claim 1 is generic to Claims 2-26 and 29-30.

This is not found persuasive because **applicant did not submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case.** In either instance, if the

examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The requirement is still deemed proper and is therefore made FINAL.

### **Continuation - In - Part**

2. Applicant declared this application is CIP of 09/992,361 filed on 11/19/2001 which is **improper** because it does not comply with the requirement of 35 U.S.C. 120: **There is no common inventor** as required by 35 U.S.C. 120. (see MPEP 201.08 Continuation - in - Part Application [R - 1])

The alleged continuation - in - part application complies with the following formal requirements of 35 U.S.C. 120:

1. The first application and the alleged continuation - in - part application were filed with at least one common inventor;
2. The alleged \*>continuation - in - part< application was "filed before the patenting or abandonment of or termination of proceedings on the first application or an application similarly entitled to the benefit of the filing date of the first application"; and
3. The alleged \*>continuation - in - part< application "contains or is amended to contain a specific reference to the earlier filed application."

For notation to be put on the file wrapper by the examiner in the case of a continuation - in - part application see MPEP § 202.02. See MPEP § 708 for order of examination.

### Information Disclosure Statement

3. If applicant is aware of any relevant prior art, he/she requested to cite it on form **PTO-1449** in accordance with the guidelines set forth in M.P.E.P. 609.

### Claims Rejection Under 35 USC - 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-3 and 5-10 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by **Olney** (6,641,263).

Olney discloses sunglasses with removable sealing member comprises a first lens 14 and a second lens 14'; a frame with a half-jacket frame front 10 adapted to receive the first lens and the second lens; and a removable shield 42 for reducing direct impingement of moving unfiltered air and dust on a wearer's eye, the removable shield configured to extend from the half-jacket frame front to the wearer's face and having two lens openings, wherein the removable shield forms a first tunnel between the first lens and the wearer's first eye and a second tunnel between the second lens and the wearer's second eye; wherein the removable shield has a uniform thickness (see figure 5 and the related disclosure.)

### Claims Rejection Under 35 USC - 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Olney** (6,641,263) in view of **Wilson** (5,583,583).

Olney discloses sunglasses with removable sealing member comprises a first lens 14 and a second lens 14'; a frame with a half-jacket frame front 10 adapted to receive the first lens and the second lens; and a removable shield 42 for reducing direct impingement of moving unfiltered air and dust on a wearer's eye, the removable shield configured to extend from the half-jacket frame front to the wearer's face and having two lens openings, wherein the removable shield forms a first tunnel between the first lens and the wearer's first eye and a second tunnel between the second lens and the wearer's second eye; wherein the removable shield has a uniform thickness (see figure 5 and the related disclosure.)

Olney does not disclose a front frame made of Titanium (claim 4) and a slip resistor carried by the temple (claims 11 and 12).


Wilson, however, discloses that a frame 12 made of Titanium and a slip resistor 82 carried by the temple 14.

Because Olney and Wilson are both from the same field of endeavor, the purpose of economical to manufacture and securing the eyeglass on the head of the wearer as disclosed by Wilson would have been recognized as an art pertinent art of Olney.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the sunglasses with removable sealing member, such as the one disclosed by Olney, with a frame made of Titanium and a slip resistor carried by the temple, such as disclosed by Wilson for the purpose of economical to manufacture and securing the eyeglass on the head of the wearer.

6. Any inquiry concerning this communication should be directed to Examiner Dang at telephone number (571) 272-2326.

4/05

A handwritten signature in black ink, appearing to read 'Hung Dang', with a stylized, cursive script.

HUNG DANG

PRIMARY EXAMINER

TC 2800